

REMARKS

Claims 1,4-28, 30, 31, 34 and 36 – 70 are pending in the application, with claims 50 – 68 being withdrawn from consideration. All claims are rejected and the rejection has been made final.

Claims 1, 4,-28, 30, 30, 34 and 36 -49, and 69-70 are rejected under 35 USC 103 (a) as being unpatentable over Haeberli *et al.* (US 4,228,297) in view of Grant *et al.* (Chemical Dictionary, 1990, p. 11-12). This rejection is respectfully traversed.

For at least the reasons stated in Applicants' last response dated July 16, 2008, Haeberli *et al.* and the cited pages of the Chemical Dictionary do not individually or in combination teach or suggest Applicants' claimed invention.

The Examiner, in reply to Applicants' July 16, 2008 response, focuses on three points. The first concerns whether or not Haeberli *et al.* allows for the first and second catalyst to be the same or different from one another. It has been and still is Applicants' position that Haeberli *et al.* teaches the use of two catalysts, one being different from the other. In Applicants' July 16 response, 15 citations taken from Haeberli *et al.* testify well to the Haeberli *et al.* teaching that the first and second catalyst are different from one another. The Examiner's counter argument is that since the first and second catalyst can be chosen from a list of compounds and classes of compounds that it is necessarily so that the choice for the first and second catalyst can be the same. That is not the teaching of Haeberli *et al.*—instead the teaching of Haeberli *et al.* is reflected in the 15 citations. Applicants' repeat these citations here for the Examiner's convenience.

- A) The Abstract states “. . . a second catalyst which is different from the first catalyst.”
- B) At column 5, lines 15-18, it is stated in effect that the second reaction is carried out in the presence of a second alkaline catalyst “which may be different from the first catalyst.”
- C) At column 8, lines 55-57, reference is made to addition of from 0 to 30 mole percent, preferably from 1 to 5 mole percent “of a second alkaline catalyst, different from the first alkaline catalyst.”

- D) In Example 1, potassium t-butoxide was used in the first step reaction and in the second step, lithium hydroxide monohydrate was used (column 10, lines 34 and 44, respectively).
- E) At column 10, lines 64-68, reference is made to using sodium methoxide or potassium methoxide instead of the potassium t-butoxide of Example 1 as the first catalyst, and lithium hydroxide monohydrate as the second catalyst.
- F) Example 2 used the same procedure as in Example 1, with an exception not involving the catalyst, and thus the disclosure is to the effect that the same catalyst system was used as in Example 1.
- G) Example 3 used the same procedure as in Example 1, with exceptions not involving the catalyst, and thus the disclosure is to the effect that the same catalyst system was used as in Example 1.
- H) In Example 4, sodium methoxide was used in the first step reaction and in the second step, ground lithium amide was used as the second catalyst (column 11, lines 48-49, and 58, respectively).
- I) Example 5 used the same procedure as in Example 4, with exceptions not involving the catalyst, and thus the disclosure is to the effect that the same catalyst system was used as in Example 4.
- J) Example 6 used the same procedure as in Example 3, except that instead of potassium t-butoxide in the first step reaction, sodium methoxide was used and instead of using lithium hydroxide monohydrate in the second stage reaction, lithium amide was used.
- K) Example 7 used the same procedure as in Example 3, with exceptions not involving the catalyst. Thus, the catalyst used in the first step was potassium t-butoxide and lithium hydroxide monohydrate was used in the second step.
- L) In Claim 1, at column 13, lines 37-38, "from 0 to 10 mole percent of a second alkaline catalyst which is different from the first catalyst" is specified.
- M) In Claim 2, at column 14, lines 23-25, "from 0 to 10 mole percent of a second alkaline catalyst which is different from the first catalyst" is specified.
- N) In Claim 3, at column 15, lines 55-57, "from 0 to 10 mole percent of a second alkaline catalyst which is different from the first catalyst" is specified.

- O) In Claim 4, at column 16, lines 37-38, “from 0 to 10 mole percent of a second alkaline catalyst which is different from the first catalyst” is specified.
- P) Claims 5-19 depend from Claims 1, 2, 3, and/or 4, and thus pursuant to 35 U.S.C. 112, “a claim in dependent form shall be construed to incorporate by reference all limitations of the claim to which it refers.” Therefore, Claims 5-19 specify “from 0 to 10 mole percent of a second alkaline catalyst which is different from the first catalyst”, which are the limitations set forth in Claims 1-4.

It is the entirety of the teaching of Haeberli *et al.* that is of importance. See *Bausch & Lomb v. Barnes-Hind/Hydocurve*, 796 F.2d 443, (July 14, 1986, wherein the CAFC stated:

“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one skilled in the art.”

Considering the totality of the Haeberli *et al.* teaching, the skilled artisan would easily understand that Haeberli *et al.* teaches the use of two different catalysts that may be chosen from a listing of compounds and classes of compounds. The rejection of Applicants’ claims on the basis that Haeberli *et al.* teaches otherwise is not well founded and should be withdrawn.

Next the Examiner challenges Applicants’ assertion that the prior art does not teach neutralization of the catalysts species with phosphoric acid. The Examiner’s counter argument is that Applicants have admitted that acetic acid (used in the prior art) works and that Applicants have not demonstrated superiority over acetic acid for their claimed phosphoric acid. The Examiner notes that Applicants have not provided a side-by-side comparison with respect to the claimed invention and the prior art. Finally, the Examiner alleges that Applicants have only used attorney arguments that cannot take the place of evidence in the record.

First, Applicants’ application with its several Examples is in the record and is evidence. The application was submitted under the signatures of the inventors as is made clear by the signed Combined Declaration and Power of Attorney. Thus, Applicant’s application is competent evidence of that which it reports. Second, the comparative test to show the

superiority of phosphoric acid over acetic acid is a test matrix that places them side-by-side against one another to see which one effects catalyst removal in the most facile manner. The comparative test is not a comparison of the claimed process and all of its steps against the prior art and all of its steps. Fortunately there is a well documented comparison of the two acids and that comparison is within easy reach.

The Examiner's attention is drawn to Examples 3, 5, and 6, Pars. [000135-141 and 000150-166]. In these Examples phosphoric acid was used to neutralize the KOH catalyst and to cause it to precipitate so that it could be easily removed by precipitation. Attention is also drawn to Example 7, Pars. [000167-177] wherein acetic acid was used to neutralize the potassium catalyst. Unlike the use phosphoric acid, the use of acetic acid did not produce a filterable precipitate, in fact no solid precipitations were observed. Thus, actual experimentation shows the superiority of phosphoric acid over acetic acid. The Examiner should remove the argument of equivalency between the two acids as a reason in support of rejection the claims.

Lastly, the Examiner rejects Applicants' contention that Haeberli, *et al.* only shows crystallization after neutralization to remove catalyst residues. See Haeberli *et al.*, col. 9, lines 9-34 and col. 10, lines 55-62. The basis for the Examiner's rejection is that Applicants' claims do not disallow crystallization. Applicants respond that, indeed, their claims exclude crystallization because they specifically call for forming the precipitated phosphate salt by neutralization (in all claims) and the removal of that precipitate by filtration (in some of the claims). Since the use of phosphoric acid forms a precipitate, there is no need or room in the process to add a useless crystallization step. It is when the practitioner uses acetic acid as the neutralizing acid that crystallization is needed since a solid precipitate does not form. See Applicants' Example 7. Thus, the fact that crystallization is not specifically stated to be excluded does not mean it is not in fact excluded by its lack of utility in Applicants' claimed invention. There is no teaching in Haeberli *et al.* that crystallization is to be used when the formation of the precipitate is by the neutralization step. The rejection of the claims on the basis of failure to exclude crystallization is not supportable and should be withdrawn.

A prompt and favorable Action is respectfully requested. If, however, any matters remain that require further consideration, the Examiner is requested to telephone the undersigned so that such matters can be discussed, and if possible promptly resolved.

Respectfully submitted,

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